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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,883	03/15/2004	Thomas N. Troxell	008932-924-999	4488
51832	7590	12/28/2005	EXAMINER	
JONES DAY			KIM, JOHN	
222 EAST 41ST STREET			ART UNIT	
NEW YORK, NY 10017-6702			PAPER NUMBER	

3733

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/801,883	Applicant(s) TROXELL ET AL.	
	Examiner John Kim	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-96 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14-21, 30-42, 46-52, 61-73, and 77-84 is/are rejected.
- 7) ☒ Claim(s) 11-13, 22-29, 43-45, 53-60, 74-76 and 85-92 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/9/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

Claims 6 and 7 are objected to because of the following informalities:

Claim 6 states "flat surface" rather than "flat top surface" as stated in claim 1.

Claim 7 states "arcuate portion" rather than "arcuate section" in claim 1.

To avoid confusion, please make all references consistent throughout the application.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 and 9 recites the limitation "side edges" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "juncture" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4, 6-14, 17,18, 34, 35, 37, 39-45, 48-49, 65-67, 69-77, and 80-81 are rejected on the ground of nonstatutory double patenting over claims 1-16 of U. S. Patent No. 6736817 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The difference between the application claims and the patent claims lies in the fact that the patent claims include more elements and are thus much specific. Thus the invention of the patent claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed.

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Cir. 1993). Since the application claims are anticipated by the patent claims, they are not patentably distinct from the patent claims.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 1, 4, 8, 10, 22-33, 34, 37, 40, 42, 53-64, 65, 67, 71, 73, 85-96 are rejected on the ground of nonstatutory double patenting over claims 1, 2, and 5-17 of U. S. Patent No. 6283967 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The difference between the application claims and the patent claims lies in the fact that the patent claims include more elements and are thus much specific. Thus the invention of the patent claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the patent claims, they are not patentably distinct from the patent claims.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of

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the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 14-21, 30-42, 34-42, 46-52, 65-73, and 77-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Korotko et al (US Pat 5312405, in IDS) in view of Davis (US Pat 5611800, in IDS).

Regarding claim 1-5, 34-38, and 65-68, Korotko teaches of having a transconnector with a first member (left portion in figure 2) with a hook (14), a projection (40) with an arcuate section (between the hook and the projection). Though Korotko teaches to have a flat surface but not on the top, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a top flat surface, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Korotko teaches of having a second member (the right portion in figure 2) with a hook (14) with a cavity (near 40), a locking assembly (42) having 2 positions (in and out). Korotko teaches the locking assembly (a single screw (42)) does not directly press the projection against the cavity. Furthermore, when the user tightens the locking assembly (42), the projection (40) is

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pressed against the cavity. The locking assembly thus prevents the uncoupling of the two members by limiting the translation and rotation of the first member.

Regarding claims 6-10, 14-19, 39-42, 46-50, 69-73, and 77-82 Korotko does not teach of having a projection with a medial wall. Davis teaches of having a projection (162) with a medial wall (171) on the top surface. (see figure 5) The projection includes side edges (166 or 173) at the juncture of the flat surface and arcuate portion. Thus, the side edges interacting with the locking assembly, would limit the rotation and translation movement of the projection. Also, Davis teaches of having a threaded hole to receive the locking assembly that directly interacts with the projection. This hole is perpendicular to the projection and would allow a stronger locking mechanism. It would have been obvious to one skilled in the art at the time the invention was made to construct the invention of Korotko (transconnector) in view of Davis, in order to have a better locking mechanism to prevent the two members from separating.

Regarding claim 20-21, 51, 52, 83, and 84, Korotko teaches the cavity to be integrally part of the second member and the projection is integrally part of the first member.

Claims 30-33, 61-64, and 93-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Korotko et al (US Pat 5312405, in IDS) in view of Davis (US Pat 5611800, in IDS) as applied to claim 1 above, and further in view of Cotrel (US Pat 5487742).

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As stated above, Korotko in view of Davis teaches of a transconnector. However, they fail to teach of having a clamping screw in the hook portion. Cotrel teaches of having a hook portion with a threaded hole (8) to receive a clamping screw (9). The purpose of the clamping screw is to secure the hook to the spinal rods. It would have been obvious to one skilled in the art at the time the invention was made to construct the invention of Korotko in view of Davis, and in further view of Cotrel, in order to secure the transconnector to the spinal rods.

Regarding claim 31-33, Cotrel teaches of having a screw with an end for receiving a tool (11), a threaded portion and a conical portion (9, see figure 3). Cotrel further teaches of having a tip (d) and a curved portion (6) having a radius larger than the spinal rods. Thus the spinal rods are clamped between the conical portion of the screw, and the region near the tip portion of the hook. These limitations allow the spinal rods to be secured to the transconnector. Thus, it would have been obvious to one skilled in the art at the time the invention was made to construct the invention of Korotko in view of Davis, in further view of Cotrel, in order to have a secure clamping of the spinal rods by the transconnector.

Allowable Subject Matter

Claims 11-13, 22-29, 43-45, 53-60, 74-76 and 85-92 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (571) 272-2817. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JK 


CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700